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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,380	10/23/2001	William Brum	B01-50	4120
7590 03/23/2004				
D. Michael Burns Acushnet Company 333 Bridge Street Fairhaven, MA 02719				
			EXAMINER CROWELL, ANNA M	
			ART UNIT 1763	PAPER NUMBER

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	10/037,380	BRUM, WILLIAM	
	Examiner	Art Unit	
	Michelle Crowell	1763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-3, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oyachi et al. in view of Usui et al. (U.S. 5,591,268).

Referring to Figures 1, 1B, 2, and column 3, lines 44-63, Oyachi et al. discloses an apparatus for treating a golf ball surface comprising a sealed casing 1, a tumbler 5 for holding golf balls 6 in the casing, and an electric source 7 for applying high voltage across the electrodes 1, 8 in order to generate glow discharge (col. 3, lines 44-53), wherein the improvement comprises the tumbler further having a plurality of perforated holes in a staggered pattern covering a substantial portion of the tumbler surface (col. 3, lines 57-58, Fig. 1B).

With respect to claim 2, the apparatus includes a plurality of holes which are individually machined. Although the Oyachi et al. is silent on how the holes are made, this feature is not patentably distinct since a recitation of "how the holes are made" in the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Therefore, since the prior art

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structure of Oyachi et al. having a tumbler with perforated holes is capable of performing the intended use of treating golf balls, then it meets the claim.

With respect to claim 7, the apparatus further includes a pattern that yields an open hole surface area of greater than 50 percent (see Fig. 1B).

The teachings of Oyachi et al. have been discussed above.

Oyachi et al. fails to teach holes having a curved radius machined about their outer edges. Referring to Figure 6b and column 9, lines 36-44, Usui et al. teaching an apparatus having a cylindrical electrode member 22a having a curved radius machined about their outer edges. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the holes of the tumbler of Oyachi et al. with a curved radius machined about their outer edges as taught by Usui et al. since the cylindrical electrode member of Usui et al. is an equivalent structure to the tumbler electrode in Figure 2 of Oyachi et al.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oyachi et al. in view of Usui et al. (U.S. 5,591,268) as applied to claims 1-3 and 7 above, and further in view of Kaji et al. (U.S. 5,895,586).

The teachings of Oyachi et al. in view of Usui et al. are discussed above.

Oyachi et al. in view of Usui et al. fails to teach an aluminum sheet metal approximately 0.25 inches to 0.375

inches thick, and the sheet metal having a hard anodic coating applied thereon.

Referring to the abstract and column 5, line 44-column 6, line 5, Kaji et al. teaches a

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glow discharge apparatus wherein the components are made of aluminum having a hard anodic coating. Aluminum is a known material used in glow discharge apparatus and anodic coatings are known protective coatings. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the tumbler of Oyachi et al. in view of Usui et al. of aluminum with a hard anodic coating as taught by Kaji et al. since aluminum is a known material used in glow discharge apparatus and anodic coatings are known protective coatings.

Additionally with respect to the thickness of the aluminum sheet, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

Response to Arguments

4. Applicant's arguments filed January 7, 2004 have been fully considered but they are not persuasive.

Applicant has argued that Usui et al. fails to disclose a plurality of holes having a curved radius in the outer ridges of the holes, and thus the holes have sharp edges. However, the claim requires that "the plurality of perforated holes have a curved radius machined about their outer edges". As seen in Figure 6B, the holes are circular around the outer edges, thus yielding a curved radius (see attached Fig. 6b).

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Allowable Subject Matter

5. Claims 4-6 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: The prior art, either singly or in combinations, fails to anticipate or render obvious an apparatus for treating golf ball surfaces comprising a tumbler having a plurality of holes having a diameter of between 0.25 and 0.50 inches and edge radii of between 0.06 and 0.12 inches.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Crowell whose telephone number is (571) 272-1432. The examiner can normally be reached on M-F (8:00 - 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (571) 272-1439. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC *me*
03-18-04

me
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